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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,431	06/24/2003	David R. McCauley	DRM03-0001	9637

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/602,431	MCCAULEY, DAVID R.	
	Examiner	Art Unit	
	Gabrielle McCormick	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/24/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on June 24, 2003.

2. Claims 1-22 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on June 24, 2003 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1, 2 and 5-22** are rejected under 35 U.S.C. 102(e) as being anticipated by Lortscher et al. (US Pub. No. 2002/0111816 hereinafter referred to as "Lortscher").

6. **Claim 1:** Lortscher discloses:

- *receiving a request to create a license, the license granting the first company the right to sublicense the information, the license obligating the first company to provide the consumer with a percentage of the monies that the first company receives for sublicensing the*

information; (P[0021]: part of the fees collected by licensing is passed on to users (consumers) and P[0032]: Consumer responds agreeing to license personal information to subscribers (second company) of the privacy system (first company))

- *receiving the information;* (P[0021]: user provides information)
- *sublicensing the information to a second company;* (P[0032])
- *providing the consumer with the percentage of the monies received for sublicensing the information to the second company.* (P[0046]: "Licensing rule may include paying a fixed percentage of the privacy system operator's revenue to each user of the system.")

7. **Claims 17 and 20:** Lortscher discloses:

- *receiving a request to create a license, the license granting the first company the right to sublicense the information,* (P[0021]: part of the fees collected by licensing is passed on to users (consumers) and P[0032]: Consumer responds agreeing to license personal information to subscribers (second company) of the privacy system (first company))
- *the license obligating the first company to provide the consumer with a first percentage of the monies that the first company receives for sublicensing the information if the consumer updates the information within a certain time period and a second percentage of the monies that the first company receives for sublicensing the information if the consumer does not update the information within the certain time period;* (P[0047]: "incentives may decline over time where the user does not update their information frequently" and P[0048]: "a percentage sharing rule with a declining fee schedule" and "declining fee schedule...create(s) an incentive for each user to update or verify their licensed information.")
- *receiving the information;* (P[0021]: user provides information)
- *sublicensing the information to a second company;* (P[0032])
- *providing the consumer with either the first percentage or the second percentage of the monies received for sublicensing the information to the second company.* (P[0046]: "Licensing rule may include paying a fixed percentage of the privacy system operator's revenue to each user of the system.")

8. **Claim 2:** Lortscher discloses providing licensing percentages of 75, 60 and declining to a floor of 10% as examples of how a percentage sharing schedule. (P[0048]). Lortscher does not disclose 40%. However, it is inherent that as the fee schedule declines from 60 to 10%, 40% would become the percentage of licensing fee.

9. **Claims 5, 6, 18, 19, 21 and 22:** Lortscher discloses obtaining consent of the user based on the industry of the second company. (P[0037]: User preferences set access controls (gathering of user preferences to set access controls inherently requires consent of the user) to the information database; a user may want his information available to companies in certain industries).

10. **Claim 7:** Lortscher discloses that information includes demographic information including census bureau information (inherently includes marital, family and address information) and financial information including income.

11. **Claims 8, 9 and 10:** Lortscher discloses receiving information via the Internet (P[0025]), telephone and handheld device (P0024]).

12. **Claim 11:** Lortscher discloses receiving personal preference information such as hobbies, books and magazines. (P[0020]).

13. **Claim 12:** Lortscher discloses an email (P[0032]) with a hyperlink (P[0040]: consumers send (email) hyperlinked letters).

14. **Claim 13:** Lortscher discloses creating license prior to providing information. (P[0032]: user responds creating license and an additional authorization to collect personal information from a third party about the user. This additional information is collected after the licensing agreement is created.)

15. **Claims 14, 15 and 16:** Lortscher discloses creating the license (S.60) after information retrieval (S.50) (both from Fig. 4) and basing the license on terms in the information (P[0037]: the "terms" provided by Lortscher include user preferences such as access by company, industry, company policy, offer delivery channels and fee schedule).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17. **Claims 3-4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lortscher et al. (US Pub. No. 2002/0111816 hereinafter referred to as "Lortscher").

18. **Claims 3 and 4:** Lortscher discloses obligating *the first company to provide the consumer with a first percentage of the monies that the first company receives for sublicensing the information if the consumer updates the information within a first period of time, and a second percentage of the monies that the first company receives for sublicensing the information if the consumer updates the information within a second period of time.* (P[0047]: "incentives may decline over time where the user does not update their information frequently" and P[0048]: "a percentage sharing rule with a declining fee schedule" and "declining fee schedule...create(s) an incentive for each user to update or verify their licensed information.")

19. Lortscher does not disclose a percentage if the consumer does not update the information or that the second period of time is greater than the first period of time.

20. However, it is obvious if the consumer never updates his/her information, a reduced licensing fee would result, as well as if the consumer becomes more and more tardy in updating his/her information. Lortscher discloses using declining license fee percentages as a means of creating an incentive for each user to update their information.

21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included percentages based on updating activity and lack of updating activity in Lortscher's system for the motivation of providing a method of incenting users to keep information timely and up-to-date. (Lortscher; P[0048]).

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

23. The following U.S. patent are cited to further show the best domestically patented prior art found by the examiner:

a. U.S. Pat. No. 5,794,210 to Goldhaber et al.

b. U.S. Pub. No. 2002/0072969 to Fisher et al.

24. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

a. http://web.archive.org/web/20020205162821/www.surveyspot.com/join.htm and http://web.archive.org/web/20020601113926/www.surveyspot.com/FAQ.htm (pages documented at the Internet Archive from May 25, 2002)

b. http://web.archive.org/web/20020601160759/new5.mysurvey.com/privacy.cfm (pages documented at the Internet Archive from June 5, 2002)

25. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is 571-270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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